



PATENT
930016-2002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant(s) : SHAW et al.
U.S. Serial No. : 09/883,002
Filed : June 15, 2001
For : **CONTROLLING A MULTIPLICITY OF
BASKETBALL ARENAS**
Examiner : William M. Pierce
Group Art Unit : 3711
Confirmation No. : 1475

745 Fifth Avenue
New York, NY 10151

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Date of Deposit: April 12, 2004

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REQUEST FOR AN ORAL HEARING UNDER 37 C.F.R. 1.194

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Sir:

Appellant respectfully requests an oral hearing with regard to the above-referenced patent application. Enclosed herewith is a check for the requisite fee of \$145.00 for a small entity as

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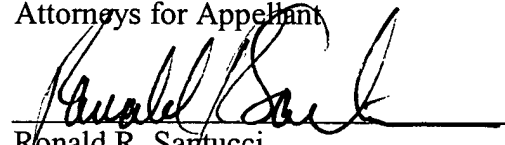
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set forth in 37 C.F.R. §1.17(d). The Commissioner is authorized to charge any additional fees that may be required to Deposit Account No. 50-0320.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP
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4-13-04

AF 3711

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REPLY BRIEF UNDER 37 C.F.R. 1.193(b)(1)

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Alexandria, VA 22313-1450

Sir:

This Reply Brief is being filed in response to the Examiner's Answer mailed February 11, 2004. This Reply Brief is filed in triplicate.

ARGUMENT

This Reply Brief is being filed in response to the argument raised by the Examiner in the Examiner's Answer. It is believed that no fee is required for the consideration of the Reply Brief. If, however, a fee is due, the Assistant Commissioner is authorized to charge such fee, or credit any over payment to Deposit Account No. 50-0320. Filed currently herewith is a Request for Oral Hearing, also in triplicate.

Claims 4-17 stand rejected under 35 U.S.C. §112, second paragraph as allegedly indefinite. Appellants disagree with the Examiner's allegations that claims 4-7, 16 and 17; and claims 10-12, 14 and 15 are indefinite. On pages 6-7, the Examiner questions the metes and bounds of the claims. However, the instant claims, read in light of the specification, apprise a skilled artisan of both the utilization and scope of the invention, and as the language is as precise as the subject matter permits, the instant claims are definite.

Specifically, Applicants respectfully urge that the terms "control lines" and "power lines" conveys a clear meaning to a practitioner in this art when the term is read in the context of the rest of the claim and in light of the specification. Similarly, it is respectfully urged that claims 10-12, 14 and 15 are not simply narrative. The claims may be read as providing a means for, *inter alia*, reducing cost, reducing complexity, increasing safety and consolidating electrical lines. Applicants urge that this language is precise in view of the nature of the claimed subject matter.

In view of the foregoing, Applicants urge that the specification and claims clearly define, and that, accordingly, the 112, second paragraph rejection should not be sustained.

Claims 1-18 stand rejected under 35 U.S.C. §103 over U.S. Patent 4,014,521 to Berman in view of U.S. Patent No. 3,983,553 to Kesling and further in view of matters as allegedly considered “old and well known.”

Again, Appellants take exception to the Examiner’s *nothing-is-patentable-because-everything-is-known* spin on obviousness as a basis for rendering Appellants’ invention unpatentable. This is impermissible and unjustified. Specifically, on pages 7-8 of the Examiner’s Answer, the Examiner alleges that because there are no affidavits, tests or the like, any results brought to light by the prosecution are those that would naturally flow from the application of a remote control system. Applicants disagree. Applicant need not provide affidavits, tests or the like, to show unexpected results. Indeed, following the Examiner’s reasoning, all automated applications would not be patentable. The Federal Circuit was very clear that “reliance on per se rules of obviousness is legally incorrect and must cease.” *In re Ochai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995).

Accordingly, the Examiner has not taken into account the unexpected results and superiority over the art. More specifically, the instant invention is operated with reduced cost, reduced complexity, increased safety, reduced insulation requirements, and with a consolidation of electrical lines. Indeed, one of the superior benefits of the instant invention is the cost savings that result from running low voltage control lines down to the control device, such as a key pad.

In addition, the rejection of claims 1-18 as being unpatentable over Berman and Kesling is meritless. The Examiner has not established a *prima facie* case by failing to provide the necessary teaching, suggestion, incentive or motivation for modifying the cited art in order to arrive at the instant invention.

More specifically, the Examiner states, “Berman clearly sets forth that that his invention is directed to ‘*divider nets* for sports events, such as those played on indoor courts. . . .’” (Page 8) (Emphasis added), and then presents a conclusion that basketball arenas may be used in place of tennis court arenas. But this conclusion is incorrect as it assumes that *divider nets*, which the Examiner admits Berman is directed to, may be used in place of *goals* in basketball arenas. More specifically, the Examiner disingenuously omits how *divider nets* relates to *goals* in basketball arenas. Accordingly, the Examiner uses hindsight gleaned from the invention itself to modify the teachings of Berman, which is impermissible. Accordingly, the Examiner has not established a *prima facie* case by failing to provide the necessary teaching, suggestion, incentive or motivation for modifying the cited art in order to arrive at the instant invention.

Indeed, following the Examiner’s reasoning, the combination of Berman and Kesling, would prevent the patentability of all automated applications relating to sports events.

In fact, there is no disclosure, teaching, suggestion or motivational recitation in Berman that would lead a skilled artisan to practice Appellants’ invention.

Finally, the Examiner concludes the Answer by stating that “[o]ne clearly wishing to not have to individually operate devices at their given location would clearly consider automatically controlling them from a central location as done in Kesling.” (Page 9). But it is well-settled that “obvious to try”, or “clearly consider[ing]” as the Examiner states, is not the standard upon which an obviousness rejection should be based. Therefore, applying the law to the instant facts, the rejection is fatally defective and should be removed.

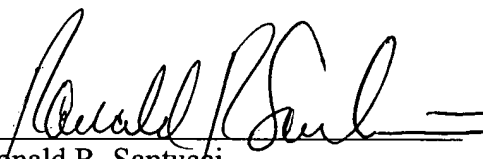
Accordingly, for at least the reasons described above, the documents cited by the Examiner fail to render claims 1-18 unpatentable under 35 U.S.C. §103(a). Therefore, the rejected claims should be allowed.

CONCLUSION

Thus, in view of the foregoing, it is respectfully submitted that the rejections under 35 U.S.C. §§ 112, second paragraph and 103(a) should be reversed by this Honorable Board and allowance of this application should be mandated.

Respectfully submitted,

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